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EXAMINER

PASS, NATALIE

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 12

Application Number: 09/658,770  
Filing Date: September 11, 2000  
Appellant(s): MCCONNELL ET AL.

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D.C. Peter Chu  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 08 March 2004.

Art Unit: 3626

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct. However Examiner notes that Appellant's statement of the issues is not concise and, as well, includes arguments including summaries of prior art and the merits of those issues, whereas 37 CFR 1.192(c) requires "[a] concise statement of the issues presented for review," and "[t]he statement would be limited to the issues presented, and should not include any argument concerning the merits of those issues."

Art Unit: 3626

**(7) Grouping of Claims**

Appellant's brief includes a statement that certain claims do not stand or fall together. However, Appellant's grouping of claims are constructively different from what Appellant notes because of how they are collectively argued. Thus Appellant's statement is not supported by reasons stating why the groupings are patentably distinct, as set forth in 37 CFR 1.192(c)(7) and (c)(8). Therefore, it is the Examiner's contention that all the claims stand or fall together, and consequently Examiner's discussion and arguments will primarily focus upon the limitations of claim 1.

In addition, Examiner notes that Appellant's stated grouping of claims as "[c]laims 1-7 stand or fall together; Claims 8-18 stand or fall together; Claims 1-7 and 19 stand or fall together" includes, within the stated groupings, those claims which were previously cancelled, claim 2 and claim 9.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

1. 5, 537, 315A Mitcham 07-1996

2. CNA Customer Services website. 03-2000

URL:<[http://web.archive.org/web/20000311214508/www.cna.com/group/custserv/gr\\_state.html](http://web.archive.org/web/20000311214508/www.cna.com/group/custserv/gr_state.html)>.

3. MostChoice Advisor website. 08-2000

URL:<[http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor\\_Center/Why/G\\_Adv\\_Why\\_Overview.cfm](http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor_Center/Why/G_Adv_Why_Overview.cfm)>.

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 19 are rejected under 35 U.S.C. 102(b).

Claims 4-8, 10-19 are rejected under 35 U.S.C. 103(a).

These rejections are set forth in prior Office Actions, Papers No. 5 and 8 and reproduced hereinbelow. The rejections which appear below substantially repeat the rejections made in the previous Office Actions (Papers No. 5 and 8). The text of those sections of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office actions, Papers 5 and 8.

1. Claims 1, 3, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitcham, U.S. Patent Number 5, 537, 315.

(A) As per claims 1, 3, Mitcham teaches a method for providing an insurance policy via a distributed computing network (Mitcham; see at least Figure 1, Items 22, 30, 32, 34, 36, column 3, lines 30-61), comprising:

receiving a request for a bindable premium quotation for an insurance policy (Mitcham; see at least Figures 3A -3G, Figure 4, Figure 12, Figure 13, column 4, lines 9-31, column 5, lines 1-4, 52-65, column 6, lines 53-60);

gathering underwriting information from one or more outside information resources based upon the identify of said individual (Mitcham; Figure 3G, column 7, lines 54-64);

determining whether said insurance policy may be underwritten (Mitcham; Figure 3G, column 8, lines 1-23);

Art Unit: 3626

in response to determining that said insurance policy may be underwritten, calculating a premium for said insurance policy and providing said premium to a requestor of said premium quotation as a bindable insurance premium quotation (Mitcham; see at least Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 14-16, column 7, lines 51-65, column 8, lines 37-47);

receiving a request to purchase said insurance policy according to said bindable insurance premium quotation (Mitcham; see at least Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 22-25); and

in response to said request, re-intermediating an insurance agent and issuing said insurance policy (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67, column 2, lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column 10, line 8);

wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy, or issuing the policy on-the-spot, to an individual insured by said insurance policy (Mitcham; Figure 4, column 3, line 61 to column 4, line 32).

(B) As per claim 19, Mitcham teaches a computer-readable medium containing computer-executable instructions which, when executed by a computer, cause the computer to perform the method of Claims 1, 3 (Mitcham; see at least Figure 1 column 3, lines 30-61).

2. Claims 4-8, 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent Number 5, 537, 315 in view of CNA Customer Services State Sales Offices website, hereinafter known as CNA, URL:

Art Unit: 3626

<[http://web.archive.org/web/20000311214508/www.cna.com/group/custserv/gr\\_state.html](http://web.archive.org/web/20000311214508/www.cna.com/group/custserv/gr_state.html)>, and further in view of MostChoice Advisor website, hereinafter known as MostChoice, URL:

<[http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor\\_Center/Why/G\\_Adv\\_Why\\_Overview.cfm](http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor_Center/Why/G_Adv_Why_Overview.cfm)>.

(A) As per claims 4-7, Mitcham teaches a method as analyzed and discussed in claim 1 above.

Mitcham fails to explicitly disclose a method wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents, including providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected or assigned insurance agent; and

remitting a commission to said selected or assigned insurance agent,

wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

CNA teaches a method wherein re-intermediating an insurance agent comprises:

Art Unit: 3626

providing a list of available insurance agents, including providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual (CNA; pages 1-10);

receiving the selection of a selected agent from the list of available insurance agents by fax or e-mail or phone (CNA; pages 1-10)

transmitting information regarding said individual and said insurance policy to said selected insurance agent by fax or e-mail or phone (CNA; pages 1-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method for providing an insurance policy via a distributed computing network of Mitcham to include wherein re-intermediating an insurance agent comprises providing a list of available insurance agents, including providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual, receiving the selection of a selected agent from the list of available insurance agents and transmitting information regarding said individual and said insurance policy to said selected insurance agent, as taught by CNA, with the motivation of assisting and enabling customers to find the and utilize the information they need when purchasing insurance (CNA; pages 13, 16).

Mitcham and CNA do not explicitly disclose

assigning said selected insurance agent to said insurance policy including

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual;

transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and



Art Unit: 3626

remitting a commission to said selected or assigned insurance agent wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

MostChoice teaches

assigning said selected insurance agent to said insurance policy including

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual; (MostChoice; see at least pages 1, 3, 10);

transmitting information regarding said individual and said insurance policy to said assigned insurance agent (MostChoice; see at least page 6); and

remitting a commission to said assigned insurance agent (MostChoice; see at least page 8)

wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer (MostChoice; see at least pages 1-4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the collective teachings of Mitcham and CNA to include assigning said selected insurance agent to said insurance policy and remitting a commission to said selected insurance agent wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer, as taught by MostChoice, with the motivation of educating and empowering potential customers to purchase insurance by connecting them with certified local advisors who are knowledgeable experts, don't let customers "fall through the cracks," are always available to answer questions, and can help customers get what they want without any pressure, and to entice the best agents (MostChoice; pages 1, 6, 8, 10).

Art Unit: 3626

(B) Claim 8 differs from claim 1 in that it is a system for providing an insurance policy via a distributed computing network rather than a method for providing an insurance policy via a distributed computing network.

As per claim 8, Mitcham, CNA and MostChoice teach a system for providing an insurance policy via a distributed computing network (Mitcham; see at least Figure 1, Items 22, 30, 32, 34, 36, column 3, lines 30-61), comprising:

a server computer maintaining a virtual insurance producer Web site available via said distributed computing network (CNA; pages 1-19), (MostChoice; pages 1-9), and wherein said virtual producer Web site is operative to:

receive a request for a bindable premium quotation for an insurance policy (Mitcham; see at least Figures 3A -3G, Figure 4, Figure 12, Figure 13, column 4, lines 9-31, column 5, lines 1-4, 52-65, column 6, lines 53-60);

receive information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be provided by said insurance policy in response to said request (Mitcham; Figure 3G, column 7, lines 54-64), (MostChoice; pages 1-5);

gather underwriting information from one or more outside information resources based upon the identify of said individual (Mitcham; Figure 3G, column 7, lines 54-64);

determine whether said insurance policy may be underwritten (Mitcham; Figure 3G, column 8, lines 1-23), (MostChoice; page 3);

to calculate a premium for said insurance policy and to provide said premium to a requestor of said premium quotation as a bindable insurance premium quotation (Mitcham; see at

Art Unit: 3626

least Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 14-16, column 7, lines 51-65, column 8, lines 37-47), (CNA; pages 18-19), (MostChoice; pages 1-3, 8, 10);

receive a request to purchase said insurance policy according to said bindable insurance premium quotation (Mitcham; see at least Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 22-25);

re-intermediate and insurance agent (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67, column 2, lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column 10, line 8); and

issue said insurance policy (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67, column 2, lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column 10, line 8).

The motivations for combining the respective teachings of Mitcham, CNA and MostChoice are as given in the rejection of claims 1 and 4 above, and incorporated herein.

(C) As per claims 10-13, Mitcham, CNA and MostChoice teach a system as discussed and analyzed in claim 8 above wherein said virtual producer Web site is further operative to:

provide an interactive help system to a requestor of said insurance policy (MostChoice; see at least pages 1-4, 6, 8, 12);

wherein said interactive help system comprises an interactive chat facility or Advisor Connect service for providing real-time communication between said requestor of said insurance policy and an insurance help-desk representative (MostChoice; see at least pages 1-4, 6, 8, 11) and

Art Unit: 3626

wherein said interactive help system further comprises an e-mail facility for receiving an electronic mail message from said requestor of said insurance policy and transmitting said message to an insurance help-desk representative (CNA; pages 1-10), (MostChoice; see at least pages 1-4, 6, 8, 12) and

wherein said interactive help system further comprises a facility for notifying an insurance help-desk representative that said requestor of said insurance policy would like to receive a telephone call providing assistance (MostChoice; see at least pages 1-4, 6, 8, 11).

(D) As per claims 14-15, Mitcham, CNA and MostChoice teach a system as discussed and analyzed in claim 8 above wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy, or issuing the policy on-the-spot, to an individual insured by said insurance policy (Mitcham; Figure 4, column 3, line 61 to column 4, line 32) and wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents (CNA; pages 1-10);

receiving the selection of a selected agent from the list of available insurance agents (CNA; pages 1-10);

assigning said selected insurance agent to said insurance policy (MostChoice; see at least pages 1, 3, 10);

transmitting information regarding said individual and said insurance policy to said selected insurance agent by fax or e-mail or phone (CNA; pages 1-10), (MostChoice; see at least page 6); and

remitting a commission to said selected insurance agent (MostChoice; see at least page 8).

Art Unit: 3626

(E) As per claims 16-18, Mitcham, CNA and MostChoice teach a system as discussed and analyzed in claims 8 and 14 above wherein re-intermediating an insurance agent comprises:

- providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual (CNA; pages 1-10);
- receiving the selection of a selected agent from the list of available insurance agents by fax or e-mail or phone (CNA; pages 1-10);
- assigning said selected insurance agent to said insurance policy, including
- assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual; (MostChoice; see at least pages 1, 3, 10);
- transmitting information regarding said individual and said insurance policy to said selected or assigned insurance agent by fax or e-mail or phone (CNA; pages 1-10), (MostChoice; see at least page 6); and
- remitting a commission to said selected or assigned insurance agent (MostChoice; see at least page 8)

wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer (MostChoice; see at least pages 1, 3, 10).

(F) As per claim 19, Mitcham, CNA and MostChoice teach a computer-readable medium containing computer-executable instructions which, when executed by a computer, cause the computer to perform the method of Claims 4-7 (Mitcham; see at least Figure 1 column 3, lines 30-61).

Art Unit: 3626

**(11) Response to Arguments**

In the Appeal Brief filed 08 March 2004, Appellant makes the following eight arguments:

(A) The Teachings of Mitcham Do Not Square With The Version Pressed by the Examiner.

(B) The Examiner Has Utterly Failed to Establish a *Prima Facie* Case of Anticipation by Neglecting to Show That Every Claim Limitation Is Taught by Mitcham.

(C) The Examiner Has Insisted That Somehow The MostChoice Reference Must Teach Appellants' Invention Despite Evidence To The Contrary.

(D) The Unsubstantiated Knowledge of the Examiner Cannot Be Used to Supplant Knowledge of One Of Ordinary Skill in the Art.

(E) To Combine, the Approach of Mitcham Must Be Jettisoned, or the Approach of the CNA Reference Must Be Abandoned, or the Approach of the MostChoice Reference Must Be Disposed of, and the Combination Would Destroy the Operation of All the References.

(F) There Can Be No Justification for the Examiner to Introduce Two New References, Kudo and Tenma, Without Any Notice to Appellants in the Final Office Action.

(G) It is Inappropriate for the Examiner to Rely Solely on Case Law as the Rationale to Support an Obvious Rejection.

(H) A Recap of the Claimed Invention Clearly Shows That None of the Cited and Applied References Teaches, Let Alone Renders Unpatentable, the Claimed Invention.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

(A) The Teachings of Mitcham Do Not Square With The Version Pressed by the Examiner

In response to Appellant's assertion that Examiner's analysis of the Mitcham reference is incorrect, Examiner respectfully disagrees with Appellant's interpretation of the Mitcham reference. On the paragraphs bridging pages 14-15 of the Appeal Brief, Appellant analyzes Figures 3C-3G of the Mitcham reference, arguing on lines 11-13:

"If somehow this essential difference is still not apparent, here is more: After the program of Mitcham has entered terminal D to execute portions of the program of Mitcham to complete the insurance contract, the program of Mitcham enters an exit terminal ("terminal H"). See Figure 3G. From the exit terminal H (Figure 3D) the program of Mitcham loops back to decision block 318 ...[...]... allowing the user to select the option ...[...]... for a representative of an insurance company to contact the user. Note that this option to contact occurs well after the completion of the insurance contract by the looping of the program to decision block 318 from the exit terminal H."

With respect to this argument, Examiner notes that throughout the Figures of Mitcham, it is Item E (alternatively referred to as block 274), as shown in Mitcham; (see at least Figure 3F) and not Item H, which represents exiting Mitcham's program (also please see at least Mitcham; column 8, lines 57-61). Hence the option for a representative of an insurance company to contact the user does not occur "well after the completion of the insurance contract," but rather as an integral part of Mitcham's invention. See, for example, column 6, lines 19-24 of Mitcham, which states "[n]ext, the process passes to block 248 which illustrates the displaying of options. The options may include completing an application, having a representative of the company contact the user, printing a quote of the selected level of coverage, or exiting the program [emphasis

Art Unit: 3626

added]." These options are further pictured in the flow chart of Figure 3D of Mitcham, which is detailed in column 8, lines 24-36. Additionally, as noted in the applied Figure 13, lines 32-34, Mitcham provides the customer with the ability to reintermediate an insurance agent by stating "to purchase your policy, please contact AUTOSURE at (214) 325-3001."

Thus, Examiner respectfully reasserts that the system of Mitcham teaches the limitations of claim 1 that are argued by Appellant in Section (A), including receiving a request for a bindable premium quotation for an insurance policy (Mitcham; see at least Figures 3A -3G, Figure 4, Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 9-31, column 5, lines 1-4, 52-65, column 6, lines 53-60) and in response to said request, re-intermediating an insurance agent and issuing said insurance policy (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67, column 2, lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column 10, line 8).

(B) The Examiner Has Utterly Failed to Establish a *Prima Facie* Case of Anticipation by Neglecting to Show That Every Claim Limitation Is Taught by Mitcham

With regard to Appellant's assertion on pages 16-17 of the Appeal Brief that Mitcham's teaching of an "informational quotation only" fails to teach the limitations of Appellant's claim 1, Examiner interprets the teachings of a published document (as shown in Mitcham's Figure 13) offering an "informational quotation" and also offering notification that "[c]hanges in coverage will affect this proposal and premium amounts quoted" and further including instructions on how to purchase the policy by phoning (reads on re-intermediating) an agent, reads on the limitations of claim 1.



Art Unit: 3626

Furthermore, in response to Appellant's question on page 16, line 24 of the Appeal Brief as to why the "the above-cited portion of Mitcham was not originally revealed in full," Examiner notes that re-intermediating is further taught in Mitcham's column 6, lines 19-21, which states (as noted above) "[n]ext, the process passes to block 248 which illustrates the displaying of options. The options may include completing an application, having a representative of the company contact the user, printing a quote of the selected level of coverage, or exiting the program [emphasis added]." These options are further pictured in the flow chart of Figure 3D of Mitcham, which is detailed in column 8, lines 24-36.

With regard to Appellants statement on page 17, line 3 that "[n]o bindable insurance premium quotation is provided by Mitcham at FIGURE 13" Examiner understands a bindable insurance premium quotation, as defined in Appellant's specification on page 7, lines 3-5, to be "a quotation of a premium for an insurance policy that may be purchased immediately by the customer". As such, the bindable quotation has not yet been purchased but it may be purchased, as noted in the cited lines described above, and displayed in Figure 13 of Mitcham. In the case of Mitcham, it is Examiner's interpretation that if Mitcham were publishing rates that were not purchasable or bindable (and which included the advice "[c]hanges in coverage will affect this proposal and premium amounts quoted") then the information published in Figure 13 would represent a fraudulent offering. Therefore it is Examiner's interpretation that Mitcham does provide a bindable insurance quotation, in that Mitcham's insurance quotation is one that is capable of binding the insurance company to the quotation.

With regard to Appellant's assertion on page 17, lines 5-6 of the Appeal Brief that Mitcham's screen of Figure 13 is displayed "after the execution of block 246. See Mitcham at

Art Unit: 3626

Col. 6, lines 16-20," Examiner notes that Mitcham teaches re-intermediating an agent in Figure 13, as discussed above and as well in block 248 (see Figure 3C), also as discussed above, and as described in Mitcham, column 6, lines 14-26.

With regard to Appellant's citing of MPEP § 2131.01 and reference to the quotation cited in *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989): "The identical invention must be shown in as complete detail as is contained in the ... claim, (emphasis added)," Examiner notes that MPEP § 2131 states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM (emphasis added)" and that "[a] claim is anticipated only if each and every element as set forth in the claim (emphasis added) is found, either expressly or inherently described, in a single prior art reference." *Verdegaul Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). With this noted, Examiner points out that each and every element as set forth in the claim has been found in the Mitcham reference.

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Accordingly Examiner disagrees with Appellant's contention to the contrary and asserts that a *prima facie* case of anticipation has indeed been established.

(C) The Examiner Has Insisted That Somehow The MostChoice Reference Must Teach Appellants' Invention Despite Evidence To The Contrary

Art Unit: 3626

With regard to Appellant's assertion on pages 17-19 of the Appeal Brief that the MostChoice reference fails to teach the limitations "as recited in Claims 1, 8, and 19," Examiner respectfully notes that the MostChoice reference was not applied to these claims, but was brought in to disclose the limitations of claims 4-7, specifically assigning said selected insurance agent to said insurance policy including assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual; (MostChoice; see at least pages 1, 3, 10); transmitting information regarding said individual and said insurance policy to said assigned insurance agent (MostChoice; see at least page 6); and remitting a commission to said assigned insurance agent (MostChoice; see at least page 8) wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer (MostChoice; see at least pages 1-4). Hence Examiner contends that Appellant's discussion of the inadequacies of the MostChoice reference is moot.

With regard to Appellant's quotation of what is (inaccurately) purported to be Examiner's words taken from paper number 8, these words originated in *Beckman Instruments v. LKB Produkter AB*, and are accurately reproduced (in context) below:

"Nevertheless, the discovery by Applicant of one web page listed as "Under Construction" today neither proves nor disproves the enablement of these web pages at the time the claimed invention was made. Furthermore, it has been established that "[e]ven if a reference discloses an inoperative device, it is prior art for all that it teaches." *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991)."

Art Unit: 3626

(D) The Unsubstantiated Knowledge of the Examiner Cannot Be Used to Supplant Knowledge of One Of Ordinary Skill in the Art

With regard to Appellant's assertion on pages 19-20 of the Appeal Brief that the MostChoice reference fails to teach the limitations "as recited in Claims 1, 8, and 19," Examiner respectfully notes that the MostChoice reference was not applied to these claims, but was brought in to disclose the limitations of claims 4-7, as discussed above. Hence Examiner contends that Appellant's discussion of the inadequacies of the MostChoice reference is moot.

With regard to Appellant's contention that Examiner's statement that the MostChoice reference was "actively maintained" amounts to supernatural powers, these words from paper number 8, are reproduced below:

"The MostChoice website, consisting of a plethora of linked web pages, 12 of which are used as references, was actively maintained during the period cited, and recites the claimed elements as analyzed and discussed in the prior Office Action (paper number 5) and in the current Office Action. As is well known in the art, archived web pages are frequently not maintained to the present day. Many archived websites are, in fact, actively disabled by site owners using software known as robots. Nevertheless, the discovery by Applicant of one web page listed as "Under Construction" today neither proves nor disproves the enablement of these web pages at the time the claimed invention was made. Furthermore, it has been established that "[e]ven if a reference discloses an inoperative device, it is prior art for all that it teaches." *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991)."

Art Unit: 3626

(E) To Combine, the Approach of Mitcham Must Be Jettisoned, or the Approach of the CNA Reference Must Be Abandoned, or the Approach of the MostChoice Reference Must Be Disposed of, and the Combination Would Destroy the Operation of All the References

At pages 20-22 of the Appeal Brief, Appellant analyzes the applied references separately and argues each of the references individually. In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Appellant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mitcham's method and system for providing an insurance policy

Art Unit: 3626

via a distributed computing network (Mitcham; column 3, line 62 to column 4, line 3) in which the insurance agent or representative is re-intermediated following the receipt of a request to purchase an insurance policy (Mitcham; Figure 13, column 1, lines 64 to column 2, line 2, column 6, lines 20-24) to include the CNA reference, which includes providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual, receiving the selection of a selected agent from the list of available insurance agents and transmitting information regarding said individual and said insurance policy to said selected insurance agent, (CNA; pages 1-10) with the motivation of assisting and enabling customers to find the and utilize the information they need when purchasing insurance (CNA; pages 13, 16), and to modify the collective teachings of Mitcham and CNA to include the MostChoice reference, which includes assigning said selected insurance agent to said insurance policy and remitting a commission to said selected insurance agent wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer (MostChoice; pages 1-12) with the motivation of educating and empowering potential customers to purchase insurance by connecting them with certified local advisors who are knowledgeable experts, don't let customers "fall through the cracks," are always available to answer questions, and can help customers get what they want without any pressure, and to entice the best agents (MostChoice; pages 1, 6, 8, 10).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the

Art Unit: 3626

motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is

Art Unit: 3626

respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Appellant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

(F) There Can Be No Justification for the Examiner to Introduce Two New References, Kudo and Tenma, Without Any Notice to Appellants in the Final Office Action

With regard to Appellant's observation of Examiner's mention of "two new references," Examiner apologizes for this typographical error, and notes that there was no intention to introduce new references and in fact, that the references noted were not being used as a basis of rejection. Further, aside from a single token (and inadvertent) reference to Kudo and Temna in the Response to Arguments section of the Final Rejection mailed 8/12/03 (paper number 8, page 9), there was no reliance by the Examiner on any other prior art aside from the Mitcham, CNA and MostChoice references.

(G) It is Inappropriate for the Examiner to Rely Solely on Case Law as the Rationale to Support an Obvious Rejection

With regard to Appellant's argument on page 23 of the Appeal brief that Examiner relied solely on case law to support an obviousness rejection, Examiner respectfully disagrees and notes that Examiner's rejections of Appellants claimed invention in papers number 5 and 8 did



Art Unit: 3626

not rely on case law but rather that each limitation of each claim was individually addressed in both the 35 U.S.C. 102(b) and the 35 U.S.C. 103(a) rejections. Examiner notes that case law was brought into the final rejection Office Action (paper number 8) as a consequence of, and in reply to, Appellant's amendment of the claims (paper number 6).

Additionally, Examiner notes that MPEP 2144 states that "[t]he rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

With regard to Appellant's analysis and discussion of the Mitcham reference at pages 23-26 of the Appeal Brief, these features have been discussed in previous sections responding to Appellant's (A) and (B) arguments of this Examiner's Answer, and incorporated herein.

(H) A Recap of the Claimed Invention Clearly Shows That None of the Cited and Applied References Teaches, Let Alone Renders Unpatentable, the Claimed Invention

In response, to Appellant's argument on pages 26-29 of the Appeal Brief that the applied references fail to teach or suggest the subject matter of claims 1, 3-8, 10-18, all of the limitations which Appellant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Mitcham, CNA and MostChoice based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 102 and 35 U.S.C. 103(a) rejections given in the preceding sections of the present Office Action and in the

Art Unit: 3626

prior Office Actions (papers number 5 and 8), and incorporated herein. In particular, as regards claim 1, Examiner notes that Mitcham teaches re-intermediating the insurance agent following the receipt of a request to purchase an insurance policy. Note, for example, that Mitcham teaches a system where, in one embodiment, "[t]he options may include completing an application, having a representative of the company contact the user, printing a quote of the selected level of coverage, or exiting the program" (Mitcham; column 6, lines 20-24). Further, Mitcham teaches that it is known in the insurance industry for a representative or agent of an insurance company to create an insurance agreement or policy based on information obtained from a prospective insured and that an insurance rate is calculated based on the information the prospective insured provides, in addition to the level of coverage the individual desires (Mitcham; column 1, lines 64 to column 2, line 2) and as well, Mitcham advises, in Figure 13, that "no sales call will be made without your request. To purchase your policy, please contact [...insurance agency or agent...] at [...recited phone number...]", thus teaching re-intermediating the agent upon receiving a request to purchase a policy.

As such, the Examiner respectfully submits the sole teachings of the applied references either anticipates or makes obvious the invention, as presently claimed, and that it is the instant claims that fail to recite a patentable distinction over the prior art of record.

### ***Conclusion***

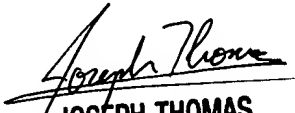
Appellant's arguments at pages 12-29 of the Appeal Brief seem to indicate that Appellant's invention is merely a combination of old and well-known elements. As specified in the remarks and rebuttals given above, Appellant's arguments apparently fail to appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied upon by the

Art Unit: 3626

Examiner for motivation to combine such well-known elements of the prior art. As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Examiner's Answer as well as the previous Office Actions (paper numbers 5 and 8), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).


Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of anticipation and of obviousness has been clearly established by the Examiner.

For the above reasons, it is believed that the rejections should be sustained.


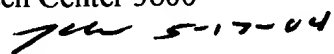
  
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Respectfully submitted,

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